

### **REMARKS**

The present application was filed on December 13, 2000, with claims 1-28, as a continuation of U.S. Patent Application Serial No. 09/549,356 filed April 14, 2000. Claims 1-28 remain pending in the present application. Claims 1 and 19 are the independent claims.

Independent claims 1 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over two different combinations of references, namely, U.S. Patent No. 6,006,039 to Steinberg et al. (hereinafter “Steinberg”) in view of U.S. Patent No. 6,587,129 to Lavendel et al. (hereinafter “Lavendel”), and U.S. Patent No. 5,541,656 to Kare et al. (hereinafter “Kare”) in view of U.S. Patent No. 6,067,624 to Kuno (hereinafter “Kuno”).

Dependent claims 2-18 and 20-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over one or more of the above-noted combinations, with certain of the dependent claim rejections incorporating additional references.

In this response, Applicants traverse the §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

A proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of at least independent claims 1 and 19, in that the proposed combinations of references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method for customizing a digital camera for at least two particular users of the digital camera by storing at least one firmware component in a programmable memory of the digital camera which controls

the operation of the digital camera. A first user selects a first desired camera feature and a second user selects a second desired camera feature which is different than the first desired camera feature. Customization software executed external to the digital camera accesses the corresponding firmware component(s) for the first and second desired camera features. The selected corresponding firmware component(s) are provided to the digital camera to enable the first desired camera feature and to disable the second desired camera feature when the digital camera is used by the first user, and to enable the second desired camera feature and to disable the first desired camera feature when the digital camera is used by the second user. The programmable memory of the digital camera is programmed to store the corresponding firmware component(s) to thereby customize the digital camera for the two users.

In an illustrative embodiment of the invention, as described at page 22, lines 18-29, of the specification, camera customization software permits two or more different sets of users to customize the feature set and GUI 25 of the digital camera 10 of FIG. 1A. The corresponding firmware components or firmware settings are stored in the Flash EPROM 28 of the digital camera 10. When the digital camera 10 is powered on, a list of users is displayed on the image display 22 and the user selects his or her name using the camera user interface 24. In response to this user input, the processor 18 uses the appropriate firmware components or firmware settings stored in the Flash EPROM 28 to provide the customized camera GUI and feature set for that particular user.

The Examiner argues that the limitations of claim 1 are met by the combined teachings of Steinberg and Lavendel, and by the combined teachings of Kare and Kuno. For the reasons identified below, Applicants respectfully disagree.

With regard to the proposed combination of Steinberg and Lavendel, the Examiner acknowledges that Steinberg fails to disclose or suggest the claimed customization of a digital camera for at least two users, but argues that the customized user interfaces in FIGS. 11a through 11e of Lavendel supply the missing teachings. However, the relied-upon user interfaces of Lavendel are not user interfaces of a digital camera. Instead, these and other user interfaces shown in Lavendel are clearly user interfaces that are displayed on display 2 of computer system 1 shown in FIG. 1 of Lavendel. This is apparent from, for example, FIGS. 2, 3, 4 and 5 of Lavendel and the

associated description at column 6, lines 49-50 and 58-60, and column 8, lines 1-8. More specifically, column 6, lines 49-50, indicates that the user interface 30 of FIG. 3 is part of a client image processing application stored on fixed disk 6 of computer system 1. FIGS. 4 and 5 indicate that the client image processing application 40 is separate from the image acquisition devices 52 and 60-62. Thus, although Lavendel indicates that a given image acquisition device may be a digital camera, it fails to provide any teaching or suggestion whatsoever regarding customizing such an image acquisition device for different users. The user interfaces of Lavendel, relied upon by the Examiner, are interfaces of a host computer connected to the image acquisition device, and not interfaces of the image acquisition device itself. The digital cameras referred to in Lavendel, such as digital camera 62 in FIG. 5 of Lavendel, are not customized for at least two users.

Accordingly, it is believed that the combined teachings of Steinberg and Lavendel fail to meet the limitations of claim 1 relating to customization of a digital camera for at least two users.

Inasmuch as claim 1 includes limitations not taught or suggested by the combined teachings of Steinberg and Lavendel, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the Steinberg and Lavendel references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine the Steinberg and Lavendel references to produce the particular limitations in question.

More particularly, the Examiner states as follows in the Office Action at page 4, first paragraph, regarding independent claim 1 and the proposed combination of the Steinberg and Lavendel references, with emphasis supplied:

[I]t would have been obvious for one skilled in the art to have been motivated to include the concept of customizing a digital camera for at least two particular users as taught in Lavendel in the configurable camera disclosed by Steinberg. Doing so would provide a means for customizing a digital camera and providing a plurality of camera features that vary according to the current user of the camera. Thus allowing different users of the camera to create a camera interface that best suits their needs.

Applicants submit that this statement is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. Also, as indicated previously, Lavendel provides no teaching whatsoever regarding customizing a digital camera for at least two users. The customization in Lavendel is of a user interface of a host computer system connected to a digital camera, and not of the digital camera itself.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 over Steinberg and Lavendel has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

Applicants also wish to point out that the Lavendel reference teaches away from the claimed invention. As noted above, Lavendel discloses a digital camera connected to a computer system, and provides customization of different user interfaces of the computer system. The failure of Lavendel to provide such user interface customization for the digital camera 62 disclosed therein is an explicit teaching away from the claimed invention.

The §103(a) rejection of claim 1 over the proposed combination of Steinberg and Lavendel is believed to be improper, and should be withdrawn.

With regard to the proposed combination of Kare and Kuno, the Examiner acknowledges that Kare fails to disclose or suggest the claimed

customization of a digital camera for at least two users, but argues that the camera control system of FIG. 1 in Kuno provides the missing teachings. However, the camera 11a in FIG. 1 of Kuno is not itself customized in any way for multiple users. The camera control server 11 may allow different users to access the camera 11a by entering passwords at associated client devices 13a and 13b, but the fact remains that the camera 11a is not changed in any way based on the particular user that is granted access to it. In other words, the camera 11a has the same set of features regardless of which user controls that camera.

Accordingly, it is believed that the combined teachings of Kare and Kuno fail to meet the limitations of claim 1 relating to customization of a digital camera for at least two users.

Inasmuch as claim 1 includes limitations not taught or suggested by the combined teachings of Kare and Kuno, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the Kare and Kuno references or modifying the reference teachings to reach the claimed invention.

The statement of motivation provided by the Examiner on this point is at pages 10-11 of the Office Action, and is as follows, with emphasis supplied:

[I]t would have been obvious for one skilled in the art to have been motivated to include the concept of enabling the use and features of a camera for a particular user as taught in Kuno in the digital camera coupled to a host computer disclosed by Kare. Doing so would provide a means for customizing a digital camera and providing a plurality of camera features that vary according to the current user of the camera. Thus allowing different users to access and control the camera one user at a time based on a password verification process.

Again, this is a subjective and conclusory statement of obviousness, of the type deemed insufficient to support an obviousness rejection in the above-cited In re Sang-Su Lee case. In addition, it fails to address the particular limitations of the claim at issue.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 over Kare and Kuno has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

Furthermore, the Kuno reference teaches away from the claimed invention. As noted above, the multiple users in Kuno are apparently all presented with the same set of features of camera 11a. The failure of Kuno to provide any customization of camera 11a for particular users is an explicit teaching away from the claimed invention.

The §103(a) rejection of claim 1 over the proposed combination of Kare and Kuno is believed to be improper, and should be withdrawn.

Independent claim 19, like independent claim 1, includes limitations relating to customization of a digital camera for at least two users, and is believed allowable for reasons similar to those identified above with regard to claim 1.

Dependent claims 2-18 and 20-28 are believed allowable for at least the reasons identified above with regard to their respective independent claims. The additional references cited by the Examiner fail to supplemental the fundamental deficiencies of the proposed combinations of references as applied to the independent claims.

In view of the foregoing, it is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

***A duplicate copy of this communication is enclosed.***

Respectfully submitted,



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Enclosures: Replacement Figure 4B